

Appl. No. : 09/929,821
Filed : August 14, 2001

REMARKS

Claims 16-42 have been cancelled as drawn to non-elected subject matter. Claims 1, 12, and 13 have been amended. As a result of the present Amendment, Claims 1-15 are pending in this application. Support for amendments is found in the existing claims and the specification as discussed below. Accordingly, the amendments do not constitute the addition of new matter. Applicants respectfully request the entry of the amendments and reconsideration of the application in view of the amendment and the following remarks.

Claim Rejection - 35 U.S.C. § 112, first paragraph

Claims 12 and 13 have been rejected as indefinite for lacking antecedent basis for the term "cellulose." Claims 12 and 13 have been amended to depend from Claim 11. In view of the foregoing amendments, Applicants respectfully request withdrawal of the rejection of Claims 12 and 13.

Claim Rejections - 35 U.S.C. § 102(b)

The Examiner has rejected Claims 1-4 and 8 under 35 U.S.C. §102(b) as being anticipated by U.S. 6,045,899 (Wang et al.). "The disclosure in an assertedly anticipating reference must be adequate to enable possession of the desired subject matter. It is insufficient to name or describe the desired subject matter, if it cannot be produced without undue experimentation." See, *Elan Pharmaceuticals Inc. v. Mayo Foundation*, 68 USPQ2d 1373 (Fed. Cir. 2003). Wang et al. does not enable a cellulosic membrane that is substantially free of macrovoids, and therefore cannot be considered as an anticipating reference under 35 U.S.C. § 102(b).

The pending independent claim recites, *inter alia*, a cellulosic membrane "wherein the membrane is substantially free of macrovoids." Wang et al. merely states that asymmetric membranes can be prepared from cellulose acetate, but does not state that such membranes would be substantially free of macrovoids. As discussed in the attached Declaration of I-fan Wang, cellulosic membranes prepared according to the teachings of Wang et al. have macrovoids. Thus, the '899 patent does not teach one of ordinary skill in the art to make the claimed invention, namely, cellulosic membranes that are substantially free of macrovoids, without undue experimentation.

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Accordingly, Wang et al. cannot anticipate Claims 1-4 or 8. Applicants therefore respectfully request that the rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 102(b) and 103(a)

The Examiner has rejected Claims 14 and 15 under 35 U.S.C. §102(b) as being anticipated by Wang et al., or, in the alternative, being obvious over Wang et al. under 35 U.S.C. §103(a). As discussed above, Wang et al. does not enable a cellulosic membrane that is substantially free of macrovoids. Accordingly, Wang et al. neither anticipates nor renders obvious Claims 14 and 15. Applicants therefore respectfully request that the rejection be withdrawn.

Claim Rejections - 35 U.S.C. § 102(b) and 103(a)

Claims 1-15 have been rejected under 35 U.S.C. §102(b) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. 3,762,566 (Del Pico). "A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference." See, e.g., *In re Paulsen*, 31 USPQ2d 1671 (Fed. Cir. 1994). To articulate a *prima facie* case of obviousness under 35 U.S.C. §103(a), the PTO must, *inter alia*, cite prior art that teaches or suggests all of the claimed limitations. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). Del Pico does not disclose every element of Applicants' claims, and therefore cannot be considered as an anticipating reference or a reference that renders obvious Applicants' claims.

The pending independent claim recites a cellulosic membrane wherein the membrane is "cast into a flat sheet" from a dope comprising a cellulosic polymer and a solvent. A membrane in the form of a flat sheet is therefore an element of the independent claim and its corresponding dependent claims. Del Pico only discloses membranes in tubular form. Del Pico neither discloses nor suggests flat sheet membranes.

Moreover, as discussed in the Declaration of I-fan Wang, the methods employed to produce tubular and flat sheet membranes differ considerably. A person of ordinary skill in the art would not look to the Del Pico reference for guidance as to how to make the presently claimed membranes. Del Pico does not disclose the manufacture of flat sheet membranes and is silent with respect to any guidance for avoidance of macrovoids. Whether the Del Pico hollow

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fiber membranes may actually have macrovoids or not, adapting the methods taught in Del Pico, so as to produce a flat sheet membrane free of macrovoids, would require undue experimentation. Likewise, as the Wang declaration establishes, a person of skill in the art would have no reasonable expectation of success in producing a flat sheet membrane that is substantially free of macrovoids by employing a method for producing a tubular membrane. Obviousness does not require absolute predictability, however, at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976).

For the reasons set forth above, Applicants respectfully request that the rejections be withdrawn.


Conclusion

In view of the foregoing amendments and remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,

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